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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,636	11/05/2002	Qi Wang	6938cip	5965
34778	7590	08/11/2004	EXAMINER	
RICHARD D. FUERLE 1711 W. RIVER RD. GRAND ISLAND, NY 14072			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 08/11/2004				

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/065,636
Filing Date: November 05, 2002
Appellant(s): WANG ET AL.

Richard Fuerle
For Appellant

MAILED

AUG 11 2004

GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/18/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 21,22,26,28,29,31,33,38 and 39.

Claims 21, 27-29, 34 and 37 have been amended subsequent to the final rejection.

Claims 34-37 are allowed.

Claims 23-25,27,30,32 and 40 are withdrawn from consideration as not directed to the elected invention.

Claims 1-20 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because, firstly, the claims are NOT to a method of inhibiting polyesters as stated in the summary.

Polyesters are not recited in the independent claims. Further, independent claim 21 also encompasses polypropylene as a polymer to which the antioxidant may be added. Finally, the claims do not recite "non-phenolic" antioxidants.

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(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The 102 rejections have been withdrawn in view of the amendments after Final. However, claims 21, 22, 26, 38, 29 and 33 are still unpatentable under 35 U.S.C. 103(a) in view of Jaeger, for the same reasons stated below with regard to claims 31, 38, and 39.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because claims 27 and 34-37 are not under appeal. Further, contrary to appellant statement, claims 31, 38 and 39 are not limited to poly(vinyl chloride).

The rejection of claims 21,22,26,28,29,31,33,38 and 39 stand or fall together because appellant's brief does not include a valid reason/statement in support of why this grouping of claims does not stand or fall together. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

A substantially correct copy of appealed claims appears on page 9-16 of the Appendix to the appellant's brief. The errors are that claims 23-25,27,30,32 34-37 and 40 should not be included in the list of appealed claims since these claims are not under appeal.

(9) Prior Art of Record

1,941,474

JAEGER

1-1934

(10) Grounds of Rejection

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The following ground(s) of rejection are applicable to the appealed claims:

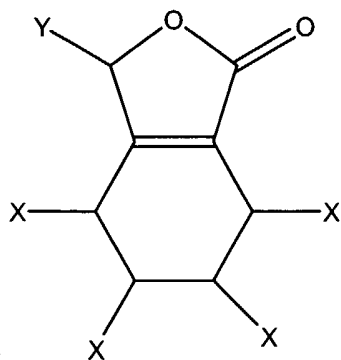
Claims 21, 22, 26, 28, 29, 31 and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. There is a lack of disclosure in the specification to enable one skilled in the art to obtain or make **all** of the antioxidants being claimed. There is no underlying reference either in the specification or in the record including where **all** the compounds within the scope of appellant's claims may be obtained commercially or how the "commercially available" compounds may be prepared.

A reasonable correlation must exist between the scope of that is claimed and the scope of enablement provided by appellant's specification to the person of ordinary skill in the art. Appellant does not provide enablement for all the compounds within the scope of appellant's claims and it would require undue experimentation for a routineer to prepare at least some of the representative compounds within the scope of the claims.

Claims 31, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaeger.

In page 1, lines 80-106, page 3, lines 3-9, Examples 2, 5, and 6 and claim 1, Jaeger teaches a process of combining polymers with about 3 to 10% of substituted

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phthalids , wherein at least one X is H₂ ([i.e., at least one x represent two hydrogens attached to the ring (an alicyclic ring)] and Y may represents a hydrogen and a alkyl group, for the purpose of improving the properties of the polymer compositions.

While Jaeger does not explicitly teach the compounds to be useful with the specific polymers recited in the claims, it still would have been obvious to one having ordinary skill in the art at the time the invention was made to use the compounds with such polymers because, in page 3, lines 3-91, Jaeger teach that these compounds are useful with other species of resins outside of those specifically recited in the reference, which would include the polymers recited in claim 38. The species of a genus is prima facie obvious. It is appellant's burden to establish that the resinous species recited in these claims provide some unexpected results over the applied reference(s). See *In re Woodroff*, 16 USPQ2d 1934(Fed. Cir. 1990); *In re Susi* 169 USPQ 423 (CCPA 1971).

(11) Response to Argument

Firstly, the examiner would like to bring the affirmation of the rejections in the parent case 09/2237,10 (Appeal No. 2001-0852 rendered Sep. 2002) to the attention of the board.

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Regarding the arguments against the 112, first paragraph rejections, the description in paragraphs (0008), (0010), and (0011) of the specification do not teach the preparation of **each** compound within the scope of the claims nor does it give citations for obtaining **each** compound. These paragraphs contain statements such as the "approaches [for preparing the antioxidants] are well known to those skilled in polymer chemistry" and see "general references" for chemical reactions. While the referenced sections of the specification, with regard to **some** of the claimed compounds, state that "many" derivatives of 2(5H)-furanones, thiophenones, benzo[c]thiophen-1(3H)-one, 2-thiophthalide, 3-pyrrolin-2-one or isoindol-1-one "can be purchased from commercial sources" and "[t]he remaining compounds can be easily made by a skilled synthetic organic chemist" by making derivatives of the commercially available compounds, or "another starting material using well-known organic reactions", even with the same four specific enabled antioxidants, the broad and generic descriptions do not significantly differ from the description in the parent case, in which the 112 1st ¶ rejections were affirmed by the board for lack of enablement. Appellant does not provide sufficient enablement for preparing **all the compounds within the scope of appellant's claims** and one of ordinary skill in the art would still require **undue experimentation** to prepare at least some of the antioxidants within the scope of the claims. Clearly, undue experimentation would be required in the "approaches ... well known to those skilled in polymer chemistry" and in "general references" for chemical reactions" for preparing some of these compounds from other "starting

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material using well-known organic reactions". In other words, **appellant's antioxidant could be almost anything made form almost anything.**

Regarding the rejections under 35 U.S.C. 103(a) of claims 31, 38, and 39, Appellant argues that none of Appellant's named polymer are similar to those taught in Jaeger and that "Appellant's [polymers] are usually thermoplastic while many (if not all) of the resins named by Jaeger are thermoset." However, despite this characterization, in page 1, lines 5-8, Jaeger teaches the compounds to be useful in "various plastic composition and coating compositions, notably those containing artificial resins (synthetic polymers) **of the thermoplastic type** (emphasis added)." Further in refute of Appellants suggestions, evidence for the fact that the polymers named in Appellants claims are combined with plasticizer compounds such as described in Jaeger can be found in US 3,654,187 (col. 2, lines 2-12 and 57-60), US 3,579,363 (col. 2, lines 10-11), US 4,136,087 (col. 3, lines 30-33) or US 4,774,277 (col. 2, lines 62-65). Appellant's statements regarding polymers in which the phthalid compounds would be applicable are based on appellant own assumption and are not shared or suggestion in Jaeger.

Regarding the teaching of the compounds as plasticizers in the polymers, as stated by the Board in affirmation of the rejections in the parent case,

"All that is required for finding adequate motivation under the statue is to find motivation for adding compounds within the appealed claim to the substrates to which appellants add the claimed compounds for any

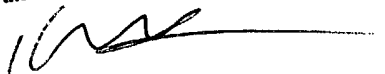
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reason, no necessarily the same reason appellants have for adding their additives."

The fact that appellant has recognized another advantage (antioxidant properties) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

For the above reasons, it is believed that the rejections should be sustained.

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PRIMARY EXAMINER



Respectfully submitted,

KCE
July 30, 2004

Conferees



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